

REMARKS/ARGUMENTS

The Office has identified the following groups of claims and is requiring an election of one of the same:

Group I: Claims 47–80, drawn to a ceramic catalyst body; and

Group II: Claims 81-94, drawn to a method of producing a ceramic catalyst body.

Applicants elect with traverse Group I, Claims 47-80, for examination.

Restriction is only proper if the claims of the restricted groups are independent or patentably distinct and there would be a serious burden placed on the Office if restriction is not required (MPEP §803). The burden is on the Office to provide reasons and/or examples to support any conclusion in regard to patentable distinction (MPEP § 803). Moreover, when citing lack of unity of invention in a national stage application, the Office has the burden of explaining why each group lacks unity with the others (MPEP § 1893.03(d)), i.e. why a single general inventive concept is nonexistent. The lack of a single inventive concept must be specifically described.

The Office alleges that Groups I-III do not relate to a single general inventive concept under PCT Rule 13.1 because, under PCT Rule 13.2, they lack the same or corresponding special technical feature for the following reasons: "Even though [the processes] of Group II include the product limitations as recited in Group I, in accordance with the MPEP rule, if the product claims are elected and once found allowable, the method claims will be rejoined with the product claims upon allowance. However, in order to expedite the prosecution and for purpose[s] of search and examination, the claims must be restricted."

Applicants thank Examiner Nguyen for his willingness to consider rejoinder of the non-elected claims upon a finding of allowability of the elected claims. However, Applicants note Annex B of the Administrative Instructions under the PCT, paragraph b (Technical Relationship), which states (emphasis added):

The expression "special technical feature" is defined in Rule 13.2 as meaning those technical features that defines a contribution which each of the inventions, *considered as a whole*, makes over the prior art. The determination is made on the contents of the claims as *interpreted in light of the description* and drawings (if any).

Applicants respectfully submit that the Office did not provide any indication of considering the contribution of each invention, *as a whole*, in alleging the lack of a special technical feature. Applicants also respectfully submit that the Office has not provided any indication that the contents of the claims *interpreted in light of the description* were considered in making this allegation. Therefore, the Office has not met the burden necessary to support the assertion of a lack of unity of the invention.

For the reasons presented above, Applicants submit that the Office has failed to meet the burden necessary in order to sustain the requirement for restriction. Applicants therefore request that the requirement for restriction be withdrawn.

Applicants respectfully submit that the above-identified application is now in condition for examination on the merits, and early notice thereof is earnestly solicited.

Respectfully Submitted,

OBLON, SPIVAK, McCLELLAND,
MAIER & NEUSTADT, P.C.



Benjamin A. Vastine, Ph.D.
Registration No. 64,422

Customer Number

22850

Tel. (703) 413-3000
Fax. (703) 413-2220
(OSMMN 08/07)